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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,626	04/15/2004	Pieter-Jan Wiersema	294-157	7869
23869	7590	06/21/2006		
HOFFMANN & BARON, LLP 6900 JERICO TURNPIKE SYOSSET, NY 11791			EXAMINER KOSLOW, CAROL M	
			ART UNIT	PAPER NUMBER

1755

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,626

Applicant(s)

WIERSEMA ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-25,27-29,31-36 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-15,17-22,25,27-29,31,32,35 and 40 is/are rejected.
- 7) ☒ Claim(s) 16,23,24,33,34 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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This action is in response to applicants' amendment of 8 May 2006. The amendments to the specification have overcome the objection to the disclosure and specification. The amendments to the claims have overcome the objection to the claims, the 35 USC 112, first paragraph rejections over claims 27 and 36; the 35 USC 101 rejection, the 35 USC 112, second paragraph rejections over 16-17, 23, 24, 27, 30 and 39. The amendments to the claims have overcome the art rejections based on EP 1,000,990; DE 3,541,434; US 4,497,919; US 6,190,572; US 3,551,169 and US 3,931,079. The amendments to the claims have overcome the 35 USC 102(b) rejections over US 4,554,083. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 19 teaches the carboxylic acids, fatty acids and mixtures thereof have a HLB value below 13 but page 44 only teaches alkoxylated carboxylic acids as having an HLB value below 13. There is no support for claiming all carboxylic acids, all fatty acids and any combinations of these acids that have an HLB value below 13. Thus this amendment is new matter.

Applicants argue that pages 44-48 support the claimed amendment, but the Examiner was unable to find any teaching in these pages teaching the claimed subject matter.

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Claims 1, 17 and 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 20 and 21 are indefinite since it is unclear how and why the multivalent, i.e. divalent and trivalent, cations do not react with the other components, as would be expected since cations, especially calcium, magnesium and zinc cations are fairly reactive.

Claims 17 and 22 are duplicate claims since they are identical. Applicant is advised that should claim 17 be found allowable, claim 22 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicants' argument with respect to the cations does not clarify the issue. If the cations react, then the product would not contain the cations. Thus the actual composition would be indefinite. There has been no showing that the claimed Ca^{+2} , Mg^{2+} and Zn^{2+} will not react and exist as only ions in the product. The rejection is maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 8-15, 17, 22, 25, 27-29, 31, 32, 35 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,554,083.

This reference teaches a wax-in-water, or water continuous emulsion, leather or shoe care product which is free of organic solvents, which means the VOC is below 1%. The composition

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is used on natural leather and mat leather, which includes nubuck and suede. The taught liquid composition is applied by a sponge or cloth to the outer surface of the shoe or leather, which means the care product reads upon the claimed impregnated towel or sponge and the reference teaches the claimed method. The composition comprises 80-97 wt% water and 3-20 wt% of an oil phase comprising about 15-45 wt% wax selected from carnauba, candellila and montanic acid wax which have a dropping or congealing point in the range of 75-90°C, about 6-24 wt% non-ionic emulsifier such as alkoxylated fatty alcohols, which are neutralized fatty acids, about 0-2 wt% hydroxyalkylamine, such as mono-, di and triethanol, as a co-emulsifier, 1-4 wt% of a water-soluble polymeric polycarboxylic acid, which is a carboxylic acid, and 0-30 wt% of optional components, such as silicone defoamers, coloring agents and preserving agent. While the water-soluble polymeric polycarboxylic acid is a pH regulator (col. 4, lines 12-15), there is no indication that it does not also act as a co-emulsifier. Thus the total amount of hydroxyalkylamine and water-soluble polymeric polycarboxylic acid is 1-6 wt%, which falls within the claimed co-emulsifier range. The taught amount of aqueous and oil phases overlap the claimed ranges. The taught amount of wax falls within and overlaps the claimed ranges. The congealing point range of the taught waxes fall within and overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). While the reference is silent as to the penetration value of the taught wax, one of ordinary skill in the art would expect the taught polishes to have a penetration value that overlaps that claimed since the taught composition overlaps the claimed composition, absent any showing

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to the contrary. While the reference does not teach the total summation of the saponification value, the hydroxyl value and the nitrogen value of all the components with more than 14 carbon atoms, one of ordinary skill in the art would expect the taught polishes to have a summation that overlaps that claimed since the taught composition overlaps the claimed composition, absent any showing to the contrary. The reference suggests the claimed care product and method.

Applicants argue the reference does not suggest the claimed co-emulsifier system, but there has been no showing that the taught carboxylic acid does not act as a co-emulsifier. The rejection is maintained.

Claims 16, 23, 24, 33, 34 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is no teaching or suggestion in the cited art of record of a shoe or leather care product in the form of a water continuous emulsion and having a VOC below 22%, based on the weight of the product, comprising 60-90 wt% of an aqueous phase, 1-50 wt% of an oil phase and an emulsifier system comprising 0.2-10 wt% of a cationic or anionic surfactant and 0.2-16 wt% of a co-emulsifier which is composed of a first component chosen from carboxylic acids, fatty acids and mixtures thereof and a second component chosen from the group of multivalent neutralizing agents, multivalent metal soaps, multivalent amines and combinations thereof.

There is no teaching or suggestion in the cited art of record of a shoe or leather care product in the form of a water continuous emulsion and having a VOC below 22%, based on the weight of the product, comprising 60-90 wt% of an aqueous phase, 1-50 wt% of an oil phase and an emulsifier system comprising 0.2-10 wt% of a surfactant and 0.2-16 wt% of a co-emulsifier

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which is composed of a first component chosen from carboxylic acids, fatty acids and mixtures thereof, a second component chosen from the group of multivalent neutralizing agents, multivalent metal soaps, multivalent amines and combinations thereof and a third component chosen from a fatty alcohol, a fatty acid ester, a fatty amine, a fatty amide, a fatty amine oxide and derivatives thereof all the listed compounds.

There is no teaching or suggestion in the cited art of record of a shoe or leather care product in the form of a water continuous emulsion and having a VOC below 22%, based on the weight of the product, comprising 60-90 wt% of an aqueous phase, 1-50 wt% of an oil phase, an emulsifier system comprising 0.2-10 wt% of a surfactant and 0.2-16 wt% of a co-emulsifier which is composed of a first component chosen from carboxylic acids, fatty acids and mixtures thereof and a second component chosen from the group of multivalent neutralizing agents, multivalent metal soaps, multivalent amines and combinations thereof and 0.05-2 wt% of at least one salt.

There is no teaching or suggestion in the cited art of record of a shoe or leather care product in the form of a water continuous emulsion and having a VOC below 22%, based on the weight of the product, comprising 60-90 wt% of an aqueous phase, 1-50 wt% of an oil phase, an emulsifier system comprising 0.2-10 wt% of a surfactant and 0.2-16 wt% of a co-emulsifier which is composed of a first component chosen from carboxylic acids, fatty acids and mixtures thereof and a second component chosen from the group of multivalent neutralizing agents, multivalent metal soaps, multivalent amines and combinations thereof and 0.1-10 wt% of at least one dimethicone copolyol/polyether modified polydimethylsiloxane having a HLB value below 8.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
June 16, 2006


C. Melissa Koslow
Primary Examiner
Tech. Center 1700